

REMARKS

This paper is submitted in response to the non-final official action dated August 26, 2009, wherein (a) claims 22-51 were pending; (b) claims 32-51 were withdrawn from consideration; (c) claims 22-31 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement; (d) claims 22-31 were rejected under 35 U.S.C. §103(a) as obvious over either DE 102 32 904 A1 ("the '904 reference") or DE 101 19 104 A1 ("the '104 reference"); and (e) claims 22-31 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over the claims of U.S. Patent Application No. 11/971,479.

By way of the foregoing, claim 22, 28, and 29 are amended. Support for the amendments to claim 22 can be found throughout the specification in combination with Figs. 1-3, for example. The amendments to claims 28 and 29 are made to improve their form, and do not introduce new matter.

Claims 22-51 are pending, of which claims 32-51 are withdrawn.

Favorable consideration of the application, as amended, is solicited.

ELECTION/RESTRICTION

The official action asserts that new claims 32-51 are directed to an invention that is independent or distinct from the invention originally claimed, i.e., recited in claims 22-31. Specifically, the official action asserts that claims 32-51 are independent from claims 22-31 because they are not connected to claims 22-31 in design, operation, or effect. The applicants respectfully submit that the official action has failed to satisfy the standard for properly requiring restriction.

Specifically, the standard for properly requiring a restriction includes two prongs. First, the claimed inventions must be independent or distinct; **and**, second, there must be a serious burden on the examiner if restriction is not required. MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the examiner must

examine it on the merits, even though it includes claims to distinct or independent inventions.

(emphasis added).

The applicants respectfully assert that the official action has failed to satisfy both the independent or distinct prong **and** the serious burden prong. Regarding the independent or distinct prong, the official action asserts that each invention is separately usable and the operation, design and effect of one is independent of the other. This is simply incorrect. Claim 22 is directed to a “cooking appliance” and claim 32 is directed to an “[o]ven rack for a cooking appliance.” Thus, both sets of claims are directed to cooking appliances in one manner or another, and therefore, it cannot be said that they are not connected in design, operation, or effect, as asserted by the official action. To the contrary, claims 22 and 32 each recite a frame, a reference body, and a positioning device for positioning the reference body in a particular manner. As such, claims 22 and 32 are certainly connected in design, operation, and effect. The “design” of each includes a frame, a reference body, and a positioning device. These components work together in each instance to perform the same “operation” and have an identical “effect.” Accordingly, a person having ordinary skill would not possibly understand claims 22 and 32 to be independent or distinct.

Moreover, the official action has neither asserted nor provided any evidence that a search and examination of the entire application as is presently before the Patent Office, would be a serious burden. Rather, the official action merely conclusively states that the groups of claims are independent. The applicants submit that this failure in and of itself renders the restriction requirement improper. Furthermore, the applicants submit that it would not be a serious burden to search and examine all of the claims together because, as mentioned above, claims 22 and 32 are connected in design, operation, and effect.

Therefore, the applicants respectfully request rejoinder of claims 32-51.

REJECTIONS UNDER 35 U.S.C. §112

The official action indicates that the original specification lacks support for the language “at least one” recited in claim 22. Claim 22 has been amended to delete this language.

Reconsideration and withdrawal of the outstanding written description rejections are respectfully requested.

REJECTIONS UNDER 35 U.S.C. §103

In rejecting claims 22-31 as obvious over the ‘904 reference or the ‘104 reference, the official action asserts that both references disclose all the claimed elements except for the positioning device being attached or fixed to a rack frame by means of at least two joining pieces which extend essentially vertically upward or downward from a base frame or upper frame. Thus, the official action conclusively states that it would have been an obvious matter of design choice to have provided either the ‘904 reference or the ‘104 reference with such obvious features, since the applicants have not disclosed that such design choices solve any stated problem and it appears that the invention would perform equally well.

Firstly, the applicants respectfully submit that such a conclusive statement of obviousness is wholly inadequate because it lacks any “articulated reasoning with some rational underpinning.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1385 (2007). That is, the official action provides no evidentiary support whatsoever as to why the claimed arrangement is obvious in light of the fact that the prior art is completely silent as to a variety of claimed features including a “positioning device being attached to the rack frame via two joining pieces which extend vertically upward or downward from the base frame or the upper frame.” Submitting that the claimed design is obvious because the applicant has not established a particularly solved problem in and of itself cannot support an obviousness rejection.

Secondly, the applicants assert that the disclosure provides ample support for the specific problem that the claimed arrangement solves. For example, the fourth full paragraph on page 4 of the English-language translation filed on January 23,

2006 explicitly describes that the present invention provides a positioning device for positioning a reference body within a cooking appliance, and which can be arranged in a user-friendly and safe manner in the vicinity of the cooked product without contaminating the cooked product with the reference body or components connected to the reference body including, for example, a cable. Neither the '904 reference nor the '104 reference discloses a reference body and, as such, a person having ordinary skill in the art would not consider it to be an obvious matter of design choice to modify either the '904 reference or the '104 reference to include not only a reference body, but also the specifically claimed positioning device for the reference body.

Accordingly, the applicants respectfully submit that the obviousness rejections are improper and should be withdrawn based on the two foregoing reasons.

In addition, the applicants submit that neither the '904 reference nor the '104 reference teaches or suggests each and every feature recited in claims 22 and 32.

The '904 Reference

The '904 reference, which is commonly-owned with the present application, describes a rack frame with a heat accumulator. Heat accumulating material is integrated into the rack frame in such a way that the frame and, in particular the lower parts of the frame, function as a heat accumulator. The '904 reference does not disclose a reference body, as recited in claims 22 and 32, or a sensor or a cooking process probe, as recited in claim 32. Moreover, as conceded in the official action, the '904 reference completely lacks any disclosure related to a positioning device, as recited in claims 22 and 32.

Furthermore, the applicants submit that it would not be obvious to modify the apparatus disclosed in the '904 reference to arrive at the claimed invention because there is no suggestion to do so. Particularly, nothing suggests adding a reference body to the '904 reference because the '904 reference appears to be completely silent as to monitoring or sensing anything during a cooking process. As such, the '904 reference cannot possibly contemplate the positioning device for the reference body recited in claims 22 and 32.

Accordingly, claims 22-51 are novel and non-obvious over the '904 reference.

The '104 Reference

The '104 reference discloses a rack frame 1, 2 for food carriers 3, 4, comprising trays 3 and dishes 4, with heating elements 5 arranged at or beneath the trays 3 when inserted into the rack frame 1, 2. The trays 3 can be provided with one or more temperature sensors 8 to measure a temperature for monitoring, documenting, and controlling the temperature of food within the dishes 4. As mentioned above, the '104 reference is completely silent as to the presence of a reference body and a positioning device for a reference body, as recited in claims 22 and 32. If the official action is interpreting one or more of the trays 3 as including a "reference body," the applicants submit that such trays 3 are by definition not attached to any frame. Rather, a person having ordinary skill in the art understands that "trays" are designed to carry items outside of the cooking system. As such, the trays 3 of the '104 reference cannot be equated to the reference body of the present invention.

Furthermore, as stated in response to the previous official action, the food carriers 3, 4 are not fixed to the rack frame 1, 2, but rather are insertable in the region of insertion planes 2. In contrast, claim 22 defines the positioning device 13 as being attached to the rack frame, and claim 32 defines the positioning device as being attached to the oven rack. The positioning devices 13 recited in claims 22 and 32 are fixed to the respective rack frame and oven rack by means of at least two joining pieces 12 which, in addition, are defined as extending essentially vertically upward or downward from the base frame 3 or upper frame 4. The '104 reference does not disclose or suggest this combination of features.

Moreover, it would not be obvious to modify the '104 reference to include these features because the '104 reference actually teaches away from a positioning device being attached to a rack frame, or oven rack, by providing the food carriers 3, 4 with temperature sensors 8 at every dish location. This requires not only a large number of temperature sensors 8, but also leads to a very complicated controlling of the cooking processes as the output values of all the temperature sensors 8 have to

be evaluated. With the present invention, only one sensor 16 within a reference body 15 is positioned by a positioning device which is part of the rack frame 1. This is a simple structure that leads to a simple control of the cooking appliance, the likes of which are not known or obvious in view of the '104 reference.

In light of the foregoing, it would not be obvious to modify the '904 or the '104 reference to arrive at the claimed invention.

Reconsideration and withdrawal of the outstanding anticipation rejections is respectfully requested.

DOUBLE PATENTING

The official action asserts that claims 22-31 of the present application are not patentably distinct from the claims of U.S. Patent Application No. 11/971,479 (hereinafter "the '479 application"). The applicants respectfully disagree, and accordingly traverse the rejection.

The present application is directed to a cooking appliance and an oven rack for a cooking appliance including a rack frame, a reference body, and a positioning device for the reference body. The '479 application is directed to a CONTAINER COMPRISING AN ARCHED BOTTOM FOR RECEIVING COOKING GOODS. Each of the claims of the '479 application recites a container for receiving cooking products, wherein a bottom of the container has an upwardly curved or arched section for directing grease during cooking. The '479 application does not even mention using a reference body in a cooking process. Accordingly, the applicants submit that the claims of the present application are completely and unambiguously patentably distinct from the claims of the '479 application.


Reconsideration and withdrawal of this provisional double patenting rejection are respectfully requested.

CONCLUSION

If there are any issues that the official action believes may be remedied by telephone conference, please feel free to contact the undersigned at (312) 474-6300.

November 24, 2009

Respectfully submitted,

By 

Michael P. Furmanek

Registration No.: 58,495
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant